IN RESPONSE TO THE OFFICE ACTION:

REJECTION UNDER 35 U.S.C. § 112:

Claims 1-13 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In response, Claim 1 has been amended regarding the specific concerns indicated by the Examiner in the Office Action. Applicant submits that the above amendments obviate the rejection of the claims under 35 U.S.C. §112, second paragraph and thus ask that the Examiner reconsider and withdraw the rejection of the claims and indicate their allowance in the next paper from the Office.

AMENDMENTS TO DRAWINGS:

Applicant has amended the drawings as requested by the Examiner and herewith provides a formal replacement sheet which includes Fig. 1.

REJECTIONS UNDER 35 U.S.C. § 102:

Claims 1-13 were rejected under 35 U.S.C. §102(b) as being anticipated by Heinzelmann *et al.* (WO 95/33631).[1]

[1] It is reminded that for there to be anticipation under 35 U.S.C. §102, "each and every element" of the claimed invention must be found either expressly or inherently described in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987) and references cited therein. See also *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 1571, 230 USPQ 81, 84 (Fed. Cir. 1986) ("absence from the reference of any claimed element negates anticipation."); *In re Schreiber,* 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997). As pointed out by the court, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. *ATD Crop. V. Lydall, Inc.*, 159 F.3d 534, 545, 48 USPQ 2d 1321, 1328 (Fed. Cir. 1998). See also *In re Spada*, 911 F.2d 705, 708, 15 USPQ 2d 1655, 1657 (Fed. Cir. 1990).

It appears that the Examiner has rejected the claims of the present application on the basis of an initial PCT search and examination report. The claims in the PCT, however, were significantly rewritten, submitted, and subsequently a favorable search report was issued. It is upon this second set of favorably viewed claims that the present claims of the instant application are based - not the first set which where negatively commented on by the European examiner. Still further, a new set of claims, 14-20, have been added to this application which correspond substantially verbatim to the second set of claims 1-8 addressed in the favorable search report issued on March 1, 2004. More specifically, the prior art document DE 4420116 A1 upon which Examiner presently relies was recharacterized in regard to these new claims by the European examiner as merely representing the "state of the art," and not otherwise substantively relevant (i.e., not X or Y references). The following statement was provided in the second, favorable International Search Report:

> **Document cited in the International Search Report:**
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> **D1: DE 44 20 116 A1**
>
> **The cited document represents the general state of the art. The invention defined in claims 1-8 is not disclosed by this document.**
>
> **The cited prior art does not give any indication that would lead a person skilled in the art to the claimed device for controlling or regulating total auxiliary brake torque in a motor vehicle. The device comprises a control system designed so that, if a limit value is exceeded or if a request is made to moderate the brake force from the auxiliary brakes, then firstly the brake torque of the retarder is turned down or moderated. Therefore, the claimed invention is not obvious to a person skilled in the art.**
>
> **Accordingly, the invention defined in claims 1-8 is novel and is considered to involve an inventive step. The invention is industrially applicable.**

For simplicity, Applicant adopts the position of the European examiner stated immediately above and respectfully requests that the §102(b) rejection be withdrawn for all claims currently pending, or specify specific disclosure in the prior art that anticipates the recitations of the claims.

The undersigned representative authorizes the Commissioner to charge any additional fees under 37 C.F.R. 1.16 or 1.17 that may be required, or credit any overpayment, to Deposit Account No. 14-1437, referencing Order No. 7589.186.PCUS00.

In order to facilitate the resolution of any issues or questions presented by this paper, the Examiner should directly contact the undersigned by phone to further the discussion.

Respectfully submitted,

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